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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,424	05/17/1999	THOMAS HUTTNER	GR-98-P-8041	3890

7590 09/04/2002

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EXAMINER
KEBEDE, BROOK

ART UNIT	PAPER NUMBER
2823	

DATE MAILED: 09/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)
	09/313,424	HUTTNER ET AL.
	Examiner	Art Unit
	Brook Kebede	2823

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 August 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *(see the attachment)*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: *21-23 and 25*.

   Claim(s) rejected: *16-20 and 24*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Continuation Sheet (PTO-303) Part of Paper No. 24

Advisory Action

1. Re claims 21-23 and 25, the Examiner has given full consideration of the amendment filed on August 9, 2002 in Paper No. 23, after Final Office Action of Paper No. 23. Applicants have amended claim 23 in order to overcome the objection that was set forth in final rejection of Paper No. 22. In the previous amendment, applicants had canceled claims 10-15 and added new claims, i.e., claims 16-25, in Paper No. 21. Claim 21 was among newly added claims. When the Examiner issued the Office action of Paper No. 22, claim 21 was not treated on its merit because it was not clear to the Examiner with respect to the dependency of claim 21 since it was written as being dependent of claim 7, which was no longer exist. In addition, claims 22, 23 and 25 were also not treated since the claims depend on claims 21. Although the objection can be obviated by the amendment, the change of dependency form claim 7 to claim 16 raises a new issue that requires further search and reconsideration for claims 21-23 and 25.

2. Applicants' amendment, with respect to claim 19, changes the scope of the claim. Therefore, the newly amended claim requires further search and consideration.

3. Applicants' argument regarding claim 24, claim objection under 35 U.S.C. § 132 and rejection under 35 U.S.C. § 112 1st paragraph, is persuasive and the rejection will be withdrawn.

4. Applicants' arguments filed on August 9, 2002, with respect to claims 16-20 and 24, have been fully considered but they are not persuasive.

Regarding rejection of claims 16-20, and 24 under 35 U.S.C. § 103, applicants argued that "Fig. 4 Hsu shows, a wafer 20 and upper layer 42 monocrystalline silicon, a middle layer 59 of nitrogen-implanted silicon dioxide, and lower monocrystalline silicon ... *Hsu* the nitrogen is

implanted into the silicon dioxide layer which is an insulator... there is no disclosure of suggestion in either *Hsu et al.* of *Sato et al.* introduce passivating substance into a monocrystalline silicon layer..."

In response to the applicants' argument, the Examiner respectfully submits that such an argument is not commensurate with the scope of the claims, in particularly, as stated above. As stated above, in part, applicants' argument is very confusing. In one hand applicants are admittedly showing that layer 42 in Hsu et al. reference is monocrystalline silicon layer, in other hand applicants are arguing Hsu et al. do not teach "passivating substance" (i.e., nitrogen ion implant) into the monocrystalline. As shown Fig. 4, as applicants correctly pointed out, Hsu et al. discloses an SOI substrate comprises the first layer (44) of monocrystalline silicon the second layer (59) of silicon oxide formed directly on the first layer and the third layer (42) of monocrystalline silicon. As figure 4 shows, the third layer (20) of the monocrystalline silicon layer is implanted with a nitrogen ion ("passivating substance") and the nitrogen penetrates through the third layer of monocrystalline silicon (20) and goes deep into the second layer of silicon oxide (59). Therefore, Examiner respectfully submits that Hsu et al. disclose introducing of "passivating substance", i.e., nitrogen ion, into a monocrystalline silicon layer. And applicants' argument has no merit given clear discloser of Fig. 4.

Further, in response to applicants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, Applicants' arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the

patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Therefore, the *prima facie* case of obviousness has been met and the rejection under 35 U.S.C. § 103 is deemed proper.

Correspondence

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brook Kebede whose telephone number is (703) 306-4511. The examiner can normally be reached on 8-5 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on (703) 308-4918. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Brook Kebede
August 29, 2002

LONG PHAM
PRIMARY EXAMINER